



Paper No. 9

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**MAY 18 2004**

**OFFICE OF PETITIONS**

**ON PETITION**

In re Application of  
Davide Grasseti and Camillo Moro  
Application No. 10/044,463  
Filed: January 10, 2002  
Attorney Docket Number: 497872000400  
Title of Invention: METHOD OF  
IMMUNOMODULATION USING THIONE-FORMING  
DISULFIDES

This is a decision on the petition filed April 19, 2004 under 37 CFR 1.137(a) to revive the above-identified application.

The petition to revive under 37 CFR § 1.137(a) is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR § 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR § 1.137(a)." This is not a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely submit a response to the Notice to File Missing Parts of Nonprovisional Application mailed March 14, 2002. The notice set an extendable 2 month period for reply. No extensions of time pursuant to 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on May 15, 2002. A Notice of Abandonment was mailed on December 15, 2003. A petition filed under 37 CFR 1.137(a) was dismissed on March 23, 2004.

#### **PETITION TO REVIVE UNDER 37 CFR § 1.137(a)**

A grantable petition under 37 CFR § 1.137(a) must be accompanied by:

- (1) the required reply,<sup>1</sup>
- (2) the petition fee,
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The instant petition lacks items (1) and (3).

<sup>1</sup> In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

As to item (1) petitioner has failed to submit the required reply. The Notice of Missing Parts required applicant to submit a completely executed declaration and the \$65 surcharge fee. The executed declaration submitted with the renewed petition only contains the signature of Camillo Moro. A review of the record shows that the Office has not received an executed declaration from Davide Grassetti. Any subsequent petition should contain the \$65 surcharge fee and an executed declaration from Davide Grassetti.

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR §1.137(a).

The Office may revive an abandoned application if the delay in responding to the relevant outstanding office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 CFR § 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" is applicable to ordinary human affairs, and requires no more greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2D 1130 (N.D. Ind. 1987).

In the present petition, petitioner states he failed to respond to the Notice of Missing Parts because he was unaware which document was missing. Petitioner further contends his former legal representative the law firm of Morrison & Foerster's negligence and malfeasance led to the abandonment of the above-identified application.

Petitioner's arguments have been considered but they are not persuasive to establish unavoidable delay. To the extent petitioner seeks to blame the failure to submit an executed declaration and the \$65 surcharge, petitioner is bound by the actions or inactions of his representative. See Link v. Wabash Railroad Co., 370 U.S. 626 (1962). If in fact Morrison & Foerster failed to submit an executed declaration and failed to prosecute the application petitioner who is treating his application as his most important business would have contacted Morrison & Foerster to insure that appropriate action was being taken on his behalf. If it was determined Morrison & Foerster were not handling the application as petitioner desired, it is then petitioner's responsibility to either timely seek other counsel or prosecute the application on his own behalf.

Although petitioner indicates he believes the actions of his attorney rises to the level of negligence and malfeasance no evidence which would allow such a finding has been presented.

As to petitioner's argument he was not aware of what document was missing, petitioner was obligated to determine what document was missing, especially where petitioner believed his legal representative was not prosecuting the application in an appropriate fashion. Petitioner could have called the USPTO on his own behalf to determine what document was missing. A person treating the application as his most important business would have taken such steps. Thus petitioner's delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay.<sup>2</sup>

Accordingly, the showing of record is insufficient to establish unavoidable delay within the meaning of 35 U.S.C. 151 and 37 CFR 1.137 (a).

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<sup>2</sup>See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2D 1130, 1132 (N.D. Ind. 1987); Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985) Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

**Alternative Venue**

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR

§ 1.137(b) must be accompanied by the required reply, the required petition fee, and a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR § 1.137(b) was unintentional.

The filing of a petition under 37 CFR § 1.137(b) cannot be intentionally delayed, and therefore, must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR § 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR § 1.137(b).

A request for a change in correspondence address must be signed by the applicant or a USPTO recognized agent or attorney before it will be entered and made of record. A change of correspondence address or a document granting access (i.e., a power to inspect) may only be signed by an attorney or agent who is not of record if an executed oath or declaration has not been filed in the application. See 37 CFR 1.33(a)

Further correspondence with respect to this matter should be addressed as follows:

By mail:	Mail Stop Petition Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
By facsimile:	(703) 872-9306
By delivery service: (FedEx, UPS, DHL, etc.)	U.S. Patent and Trademark Office 2011 South Clark Place Customer Window, Mail Stop Petition Crystal Plaza Two, Lobby, Room 1B03 Arlington, VA 22202

Telephone inquiries should be directed to the undersigned at (703) 306-0251.



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Office of Petitions

enclosure

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